

Docket No.: 0649-0963P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshihiro MORI et al.

Application No.: 10/621,715

Confirmation No.: 001567

Filed: July 18, 2003

Art Unit: 1634

For: METHOD FOR SEPARATING AND
PURIFYING A NUCLEIC ACID

Examiner: S. T. Kapushoc

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Toshihiro Mori, declare the following.

I am knowledgeable in Japanese and English.

The following section appears at paragraph [0025], page 11, line 25, and continuing to the top of page 12, lines 1-4, of JP 210832/2002, the priority parent application:

より具体的には、本発明によれば、表面酸化率が低いもの（例えば、50%以下の表面酸化率）を使用することによって異なる長さの核酸を含む核酸混合物中から比較的長い（例えば、10 kb 以上、より好ましくは30 kb 以上）核酸を分離・精製する方法が提供される。さらに、本発明によれば、表面酸化率が低い

もの（例えば、50%以下の表面鹸化率）と高いもの（例えば、50%より高い表面鹸化率、例えば100%の表面鹸化率）を組み合わせて使用することによって、異なる長さの核酸を含む核酸混合物中から比較的短い（例えば、10 kb 未満、より好ましくは2 kb 以下）核酸を分離・精製する方法が提供される。

I believe that the above paragraphs have the following English language translation:

More specifically, the invention provides a method of separating and purifying a relatively long nucleic acid (e.g., 10 kb or longer, more preferably 30 kb or longer) from the nucleic acid mixture containing nucleic acids having different lengths by using a membrane of a low surface-saponification rate (e.g., 50% or lower of surface-saponification rate). Furthermore, according to the invention, by using a porous membrane having a low surface-saponification rate (e.g., 50% or lower of surface-saponification rate) in combination with a porous membrane having a high surface-saponification rate (e.g., higher than 50% of surface-saponification rate, e.g., 100% of surface-saponification rate), there is provided a method for separating and purifying a relatively short (e.g., shorter than 10 kb, more preferably 2 kb or shorter) nucleic acid from the nucleic acid mixture which contains nucleic acids having different lengths.

However, in the present specification, the following language appears for this section, at paragraph [0063] of U.S. Patent Application Publication No. 2004/0063122, published on April 1, 2004, reflecting the original language present in the specification as-filed, at page 11, line 35 to page 12, line 14:

More specifically, the invention provides a method of separating and purifying a relatively long nucleic acid (e.g., 10 kb, or more preferably 30 kb or longer) from the nucleic acid mixture containing nucleic acids having different lengths by using a membrane of a low surface-saponification rate (e.g., 50% or lower of surface-saponification rate). Furthermore, according to the invention, by using a porous membrane having a low surface-saponification rate (e.g., 50% or lower of surface-saponification rate) in combination with a porous membrane having a high surface-saponification rate (e.g., higher than 50% of surface-

saponification rate, e.g., 100% of surface-saponification rate), there is provided a method for separating and purifying a relatively short (e.g., 10 kb or shorter, more preferably 2 kb or shorter) nucleic acid from the nucleic acid mixture which contains nucleic acids having different lengths.

Thus, it is readily apparent that there are mistranslations of the as-filed specification parenthetical text "... (e.g., 10 kb, or more preferably 30 kb or longer) ..." and "... (e.g., 10 kb or shorter, more preferably 2 kb or shorter) ..."

I believe the specification, as-filed, recites mistranslations of the original Japanese language text.

I further believe that the proper English language translation is as reflected in the text provided above, which instead states: "... (e.g., 10 kb or longer, more preferably 30 kb or longer) ..." and "... (e.g., shorter than 10 kb, more preferably 2 kb or shorter) ..."

STATEMENT UNDER 18 U.S.C. § 1001

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. Further, these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 10/01/2007

Toshihiro Mori

Signature of Declarant